



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,987	01/05/2004	Florence Laurent	6028.0007-01	5488

22852 7590 12/05/2005

FINNEGAN, HENDERSON, FARABOW, GARRETT & DUNNER
LLP
901 NEW YORK AVENUE, NW
WASHINGTON, DC 20001-4413

EXAMINER

EINSMANN, MARGARET V

ART UNIT	PAPER NUMBER
----------	--------------

1751

DATE MAILED: 12/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/750,987

Applicant(s)

LAURENT ET AL.

Examiner

Margaret Einsmann

Art Unit

1751

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 26 September 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 12,15,36,39,71 and 73-75 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 12,15,36,39,71 and 73-75 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1751

This action is in response to the amendment and remarks filed 9/26/05.

Applicant's amendment has been entered and applicant's remarks carefully considered. The pending claim are 12, 15, 25, 36, 39, 52, 71 and 73-75.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 12, 15, 25, 36, 39, 52, 71, 73-75 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Where in the specification is the basis for a quaternized non-hydroxy celluloses? Original claim 9 does not provide that basis, nor does page 5 lines 17-19 as alleged by applicant in the first paragraph of page 5 of the current response. Applicant may be referring to "quaternized hydroxyethylcellulose" as basis for the new matter inserted into claim 73. In that polymer, the cellulose is not substituted by hydroxy but by hydroxyethyl.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

The rejection of claims 12, 15, 25, 36, 39, 52, 71, 73-75 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly

Art Unit: 1751

claim the subject matter which applicant regards as the invention has been mooted except as set forth below. Claims 12 and 15 are rejected under 35 USC 112, second paragraph as being redundant since they do not further limit the composition of claim 73. Applicant has argued that the examiner has not specifically set forth the basis for this rejection. Applicant appears to be unaware that the preamble of a composition claim does not limit the ingredients per se in the composition. The three claimed compositions are of identical scope. This office is certainly aware that keratin fiber is not all hair, nor is hair all human hair. However applicant's position that the utility in the preamble limits the components in the composition is not understood. If applicant is claiming three distinct compositions, then the differences must be stated in the body of each claim.

Applicant is advised that should claim 73 be found allowable, claims 12 and 15 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. This rejection is maintained as set forth in the previous action. As stated above, the preamble does not change the scope of a claimed composition.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The rejection of claims 9-15, 25, 36, 39, 52 and 71 under 35 U.S.C. 102(b) as being anticipated by Ziegler et al., US 5,135,748 has been mooted by applicant's

Art Unit: 1751

amendment replacing claim 9 with claim 73 as the independent claim and including an oxidizing agent in the composition.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 12,15, 25, 36, 39, 52,71 and 73-75 are rejected under 35 U.S.C. 103(a) as being unpatentable over FR 2,717,383 and its US equivalent, US 5,735,908. The specification of the US patent will be used in the citations in this rejection. Patentees teach the use of quatrisoft LM 200, a hydroxyethylcellulose quaternary ammonium polymer having an alkyl group containing 12 carbon atoms (a lauryl group) in hair dyeing compositions. See col 3 lines 39-48. Applicant differs from the instant claims in not providing a working example of said polymer in a composition. In example 2 patentee provides a composition comprising Mirapol A15 quaternary polyammonium polymer which is mixed with the oxidizing agent hydrogen peroxide. It would have been obvious to one having skill in the art at the time the invention was made to substitute Quadrisoft LM 200 for all or part of the Mirapol A15 in example 2 because patentee teaches that the two polymers are equivalent in that they serve the same purpose in the hair compositions, that is they the dyeing compositions to which they are added exhibit markedly enhanced selectivity compared with those known hitherto, are more intense and remain very resistant to atmospheric agents and to cosmetic treatments. Col 1

Art Unit: 1751

lines 50 et seq. Additionally patentee states at column 2 lines 43 et seq. that the process of the invention may be varied by adding the oxidizing agent to the cationic or substantive polymer and forming a composition comprising the two components without the dye components, and then using that composition with the dye components.

Response to Arguments

Applicant's arguments filed 9/26/05 regarding the above rejection over Cotteret et al. have been fully considered but they are not persuasive for the following reasons. Applicant states that not all cationic and amphoteric substantive polymers as taught by Cotteret are cationic amphiphilic as claimed. However, the rejection is not based on all of the polymers disclosed in Cotteret, but on one specific polymer. Cotteret states in col 3 lines 26 et seq, that the cationic or amphoteric substantive polymers refers to a polymer with the ability to be deposited on keratin fibers such as hair and then goes on to specifically disclose that Quadrisoft LM200 is one of the polymers which falls within his inventive concept. It is one of the polymers that is substantive to human keratin fibers and accordingly would be expected to be successful in applicant's invention. Applicant states that there is no motivation shown to substitute Quadrisoft LM200 into the composition of the working example of Cotteret. There is no motivation needed when the reference teaches the equivalence of the compounds. The examiner is not suggesting substituting a compound from another invention (reference) into the composition of Cotteret. Cotteret himself teaches that the Quadrisoft LM200 is one of the polymers useful in his invention. Applicant asks why one would choose Quadrisoft

Art Unit: 1751

LM200 from the large genus of polymers disclosed for the substitution. In response to this question, this office states:

a) Since patentee suggests the substitution, how can we argue that it will not be successful?

b) Cotteret does not suggest a large genus of polymers. He mentions very few by name.

Applicant states that the Office has not set forth any evidence of a reasonable expectation of success in making the proposed combination. The examiner has set forth a prima facie case of obviousness. Applicant, not this office, has the burden of proof of overcoming a prima facie case of obviousness. Additionally, the rejection is not based on a combination, but on the suggestion of a single reference. Applicant further states that the examiner has not provided any specific basis on which one of ordinary skill in the art would expect the particular cationic amphiphilic polymers of the claimed invention to be successfully combined with the oxidizing agent. Since Cotteret teaches the combination, its success is expected. The patent specifically teaches the combination of polymer and oxidizing agent in col 2 lines 47 et seq. as composition (B2).

THIS ACTION IS MADE FINAL. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

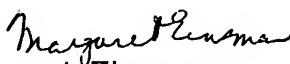
Art Unit: 1751

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Margaret Einsmann whose telephone number is 571-272-1314. The examiner can normally be reached on 7:00 AM -4:30 PM M-W and alternate Fridays. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Yogendra Gupta can be reached on 571-272-1316.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

11/28/05


Margaret Einsmann
Primary Examiner
Art Unit 1751